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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Matthew S. Solar et al.

Title: FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS

Docket No.: 723.077US1

Filed: October 17, 2003

Examiner: Unknown

Serial No.: 10/688,801

Due Date: N/A

Group Art Unit: 3737

MS Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

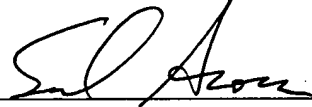
We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ A return postcard.
- ☒ A Communication Concerning Related Applications (2 pgs.).
- ☒ An Information Disclosure Statement (2 pgs.), Form 1449 (4 pgs.), and copies of 16 cited documents.
- ☒ Communication Relating to the Results of the Partial International Search (4 pgs.).

If not provided for in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

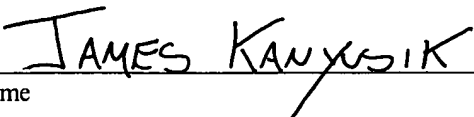
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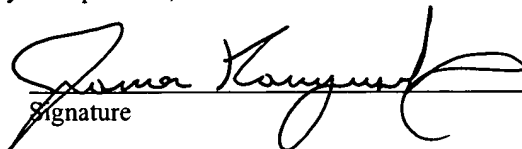
By: 

Atty: Suneel Arora

Reg. No. 42,267

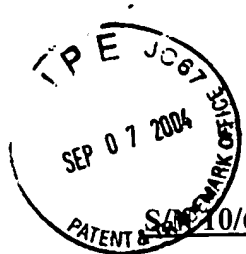
CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15 day of September, 2004.

  
Name

  
Signature

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

(GENERAL)



S/N 10/688,801

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Matthew S. Solar et al.	Examiner:	Unknown
Serial No.:	10/688,801	Group Art Unit:	3737
Filed:	October 17, 2003	Docket:	723.077US1
Title:	FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS		

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**COMMUNICATION CONCERNING RELATED APPLICATIONS**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicants would like to bring to the Examiner's attention the following related applications in the above-identified patent application:

<u>Serial/Patent No.</u>	<u>Filing Date</u>	<u>Attorney Docket</u>	<u>Title</u>
10/454145	June 4, 2003	723.058US1	FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS
10/206884	July 29, 2002	723.063US1	FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS
10/374677	February 25,2003	723.070US1	FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS
10/454786	June 4, 2003	723.073US1	FIDUCIAL MARKER DEVICES AND METHODS
29/199249	February 12, 2004	723.078US1	FIDUCIAL MARKER

INFORMATION DISCLOSURE STATEMENT

Page 2

Serial No :10/688,801

Dkt: 723.077US1

Filing Date: October 17, 2003

Title: FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS

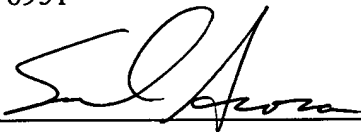
29/199266      February      723.079US1      FIDUCIAL MARKER  
                    12, 2004

Respectfully submitted,

MATTHEW S. SOLAR ET AL.

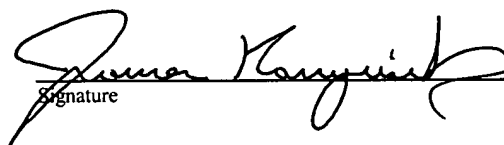
By their Representatives,

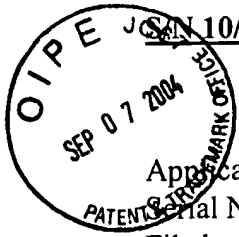
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6951

Date Sept. 1, 2004 By   
Suneel Arora  
Reg. No. 42,267

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1ST day of September, 2004.

JAMES KANYUSIK  
Name

  
Signature



10/688,801

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Matthew S. Solar et al.	Examiner:	Unknown
Serial No.:	10/688,801	Group Art Unit:	3737
Filed:	October 17, 2003	Docket:	723.077US1
Title:	FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS		

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**INFORMATION DISCLOSURE STATEMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In compliance with the duty imposed by 37 C.F.R. § 1.56, and in accordance with 37 C.F.R. §§ 1.97 *et. seq.*, the enclosed materials are brought to the attention of the Examiner for consideration in connection with the above-identified patent application. Applicants respectfully request that this Information Disclosure Statement be entered and the documents listed on the attached Form 1449 be considered by the Examiner and made of record. Pursuant to the provisions of MPEP 609, Applicants request that a copy of the 1449 form, initialed as being considered by the Examiner, be returned to the Applicants with the next official communication.

Several patents listed in the attached Form 1449 were discovered as a result of a Partial International Search conducted in Applicants' corresponding foreign patent application. Enclosed for the Examiner's information are copies of EP 1033113A1, and EP 1249207A, the two non-US cited documents, and a copy of the Partial International Search. Each patent's relevance to a specific claim is indicated on the attached Communication Relating to the Results of the Partial International Search according to MPEP 609.

Pursuant to 37 C.F.R. §1.97(b), it is believed that no fee or statement is required with the Information Disclosure Statement. However, if an Office Action on the merits has been mailed, the Commissioner is hereby authorized to charge the required fees to Deposit Account No. 19-0743 in order to have this Information Disclosure Statement considered.

**INFORMATION DISCLOSURE STATEMENT**

Page 2

Serial No :10/688,801

Dkt: 723.077US1

Filing Date: October 17, 2003

Title: FIDUCIAL MARKER DEVICES, TOOLS, AND METHODS

The present application is a U.S. national patent application filed after June 30, 2003. Thus, Applicant believes that the U.S. Patent & Trademark Office has waived the requirement under 37 C.F.R. 1.98 (a)(2)(i) for submitting a copy of each cited U.S. patent and each U.S. patent application publication. The waiver is provided in a pre-OG notice from the U.S. Patent & Trademark Office entitled "Information Disclosure Statements May Be Filed Without Copies of U.S. Patents and Published Applications in Patent Applications filed after June 30, 2003" and dated July 11, 2003. Applicant acknowledges the requirement to submit copies of foreign patent documents and non-patent literature in accordance with 37 C.F.R. 1.98(a)(2).

The Examiner is invited to contact the Applicant's Representative at the below-listed telephone number if there are any questions regarding this communication.

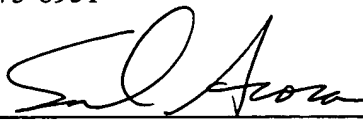
Respectfully submitted,

MATTHEW S. SOLAR ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6951

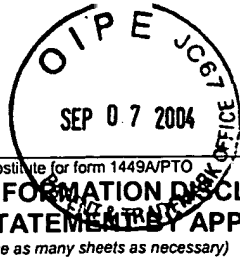
Date Sept. 1, 2004

By   
Suneel Arora  
Reg. No. 42,267

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this \_\_\_\_ day of September, 2004.

\_\_\_\_\_  
Name

\_\_\_\_\_  
Signature



Substitute for form 1449A/PTO  
**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**  
(Use as many sheets as necessary)

Complete if Known

<b>Application Number</b>	10/688,801
<b>Filing Date</b>	October 17, 2003
<b>First Named Inventor</b>	Solar, Matthew
<b>Group Art Unit</b>	3737
<b>Examiner Name</b>	Unknown

Sheet 1 of 4

Attorney Docket No: 723.077US1

**US PATENT DOCUMENTS**

Examiner Initial *	USP Document Number	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	Filing Date If Appropriate
	US-2001/0004395 A1	06/21/2001	McCrorry, J., et al.	378	162	12/22/2000
	US-2001/0010004 A1	07/26/2001	Traxel, D., et al.	606	130	12/21/2000
	US-2002/0156363 A1	10/24/2002	Hunter, Mark. A., et al.	600	410	03/21/2002
	US-4,228,799	10/21/1980	Anichkov, Andrei D., et al.	128	303B	09/22/1978
	US-4,583,538	04/22/1986	Onik, Gary M., et al.	128	303B	05/04/1984
	US-4,629,451	12/16/1986	Winters, Arthur, et al.	604	175	09/23/1985
	US-4,675,173	06/23/1987	Widder, Kenneth J.	424	9	05/08/1985
	US-4,763,548	08/16/1988	Leibinger, Karl, et al.	81	453	10/15/1986
	US-4,943,298	07/24/1990	Fujita, S., et al.	606	158	06/02/1989
	US-4,945,914	08/07/1990	Allen, G.	128	653 R	07/18/1988
	US-4,991,579	02/12/1991	Allen, George S.	128	653 R	11/10/1987
	US-5,016,639	05/21/1991	Allen, G. S.	128	653 R	02/13/1990
	US-5,042,462	08/27/1991	Bremer, Paul W.	128	75	10/30/1990
	US-5,094,241	03/10/1992	Allen, G. S.	128	653.1	01/19/1990
	US-5,119,817	06/09/1992	Allen, G. S.	128	653.1	01/19/1990
	US-5,142,930	09/01/1992	Allen, George S., et al.	74	469	03/29/1991
	US-5,178,164	01/12/1993	Allen, G. S.	128	898	03/29/1991
	US-5,186,174	02/16/1993	Schlondorff, Georg, et al.	128	653.1	01/29/1990
	US-5,197,476	03/30/1993	Nowacki, Christopher, et al.	128	660.03	10/11/1991
	US-5,201,737	04/13/1993	Leibinger, Karl, et al.	606	69	03/30/1992
	US-5,211,164	05/18/1993	Allen, George S.	128	653.1	03/29/1991
	US-5,222,499	06/29/1993	Allen, George S., et al.	128	653.1	03/26/1992
	US-5,230,338	07/27/1993	Allen, George S., et al.	128	653	04/22/1992
	US-5,263,980	11/23/1993	Leibinger, Karl, et al.	623	11	12/19/1990
	US-5,299,253	03/29/1994	Wessels, B.	378	163	04/10/1992
	US-5,305,203	04/19/1994	Raab, Simon	364	413.13	10/02/1990
	US-5,368,030	11/29/1994	Zinreich, S. J., et al.	600	414	09/09/1992
	US-5,383,454	01/24/1995	Bucholz, Richard D.	128	653.1	07/02/1992

EXAMINER

DATE CONSIDERED

Substitute Disclosure Statement Form (PTO-1449)

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional) 2 Applicant is to place a check mark here if English language Translation is attached

Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use as many sheets as necessary)	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="text-align: left; font-size: small;">Complete if Known</td> </tr> <tr> <td style="width: 60%;">Application Number</td> <td>10/688,801</td> </tr> <tr> <td>Filing Date</td> <td>October 17, 2003</td> </tr> <tr> <td>First Named Inventor</td> <td>Solar, Matthew</td> </tr> <tr> <td>Group Art Unit</td> <td>3737</td> </tr> <tr> <td>Examiner Name</td> <td>Unknown</td> </tr> </table>	Complete if Known		Application Number	10/688,801	Filing Date	October 17, 2003	First Named Inventor	Solar, Matthew	Group Art Unit	3737	Examiner Name	Unknown
Complete if Known													
Application Number	10/688,801												
Filing Date	October 17, 2003												
First Named Inventor	Solar, Matthew												
Group Art Unit	3737												
Examiner Name	Unknown												
Sheet 2 of 4	Attorney Docket No: 723.077US1												

	US-5,389,101	02/14/1995	Heilbrun, M. P., et al.	606	130	04/21/1992
	US-5,394,457	02/28/1995	Leibinger, K., et al.	378	162	10/07/1993
	US-5,394,875	03/07/1995	Lewis, J. T., et al.	128	660.09	10/21/1993
	US-5,397,329	03/14/1995	Allen, G. S.	606	73	02/26/1993
	US-5,468,242	11/21/1995	Reisberg, Erhard	606	69	11/19/1993
	US-5,494,034	02/27/1996	Schlondorff, Georg, et al.	128	653.1	06/15/1994
	US-5,551,429	09/03/1996	Fitzpatrick, J., et al.	128	653.1	06/02/1995
	US-5,566,081	10/15/1996	Yoshizawa, S., et al.	364	492	10/25/1993
	US-5,575,794	11/19/1996	Walus, R. L., et al.	606	116	01/27/1994
	US-5,590,215	12/31/1996	Allen, George S.	382	128	04/21/1995
	US-5,595,193	01/21/1997	Walus, R., et al.	128	898	06/06/1995
	US-5,603,318	02/18/1997	Heilbrun, M. P., et al.	128	630	10/29/1993
	US-5,636,255	06/03/1997	Ellis, R. E.	378	20	03/05/1996
	US-5,681,313	10/28/1997	Diez, Ingolf	606	69	01/26/1996
	US-5,730,130	03/24/1998	Fitzpatrick, J., et al.	128	653.1	06/02/1995
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	US-5,769,789	06/23/1998	Wang, M. Y., et al.	600	414	04/22/1997
	US-5,799,099	08/25/1998	Wang, M. Y., et al.	382	131	06/06/1995
	US-5,807,252	09/15/1998	Hassfeld, Stefan, et al.	600	407	10/22/1996
	US-5,807,396	09/15/1998	Raveh, Joram	606	69	12/18/1996
	US-5,836,954	11/17/1998	Heilbrun, M. P., et al.	606	130	02/18/1997
	US-5,851,183	12/22/1998	Bucholz, Richard D.	600	425	10/16/1995
	US-5,871,445	02/16/1999	Bucholz, Richard D.	600	407	09/07/1995
	US-5,891,034	04/06/1999	Bucholz, Richard D.	600	426	06/07/1995
	US-5,916,164	06/29/1999	Fitzpatrick, J., et al.	600	426	08/12/1997
	US-5,957,934	09/28/1999	Rapoport, U.	606	130	12/22/1997
	US-5,984,930	11/16/1999	Maciunas, Robert, et al.	606	130	09/30/1996
	US-6,011,987	01/04/2000	Barnett, G.	600	414	12/08/1997
	US-6,052,477	04/18/2000	Wang, M., et al.	382	131	07/06/1998
	US-6,071,291	06/06/2000	Forst, P., et al.			10/21/1998
	US-6,073,044	06/06/2000	Fitzpatrick, J., et al.	600	426	04/22/1999
	US-6,076,008	06/13/2000	Bucholz, Richard D.	600	427	02/03/1999
	US-6,082,366	07/04/2000	Wilfried, A., et al.	128	899	09/03/1996
	US-6,096,048	08/01/2000	Howard, III, M., et al.	606	130	04/20/1994
	US-6,146,390	11/14/2000	Heilbrun, M. P., et al.	606	130	02/25/2000
	US-6,165,181	12/26/2000	Heilbrun, M. P., et al.	606	130	10/15/1998
	US-6,167,295	12/26/2000	Cosman, E.	600	426	01/03/1996
	US-6,168,780	01/02/2001	Wilfried, Andra	424	9.32	02/19/1998
	US-6,181,960	01/30/2001	Jensen, M., et al.	600	431	01/15/1999

EXAMINER

DATE CONSIDERED

Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(Use as many sheets as necessary)</i>	<i>Complete if Known</i>	
	<b>Application Number</b>	10/688,801
	<b>Filing Date</b>	October 17, 2003
	<b>First Named Inventor</b>	Solar, Matthew
	<b>Group Art Unit</b>	3737
	<b>Examiner Name</b>	Unknown
Sheet 3 of 4	<b>Attorney Docket No: 723.077US1</b>	

	US-6,187,018	02/13/2001	Sanjay-Gopal, S., et al.	606	130	10/27/1999
	US-6,206,890	03/27/2001	Truwit, C.	606	130	08/23/1999
	US-6,236,875	05/22/2001	Bucholz, Richard D., et al.	600	407	10/05/1995
	US-6,261,300	07/17/2001	Carol, Mark, et al.	606	130	04/20/1900
	US-6,273,896	08/14/2001	Franck, J. , et al.	606	130	04/21/1998
	US-6,282,437	08/28/2001	Franck, J. , et al.	600	429	05/24/1999
	US-6,298,262	10/02/2001	Franck, Joel I., et al.	600	426	05/01/1901
	US-6,304,768	10/16/2001	Blume, W. , et al.	600	407	11/20/2000
	US-6,306,126	10/23/2001	Moctezuma, Jose-Luis	606	1	09/09/1999
	US-6,327,491	12/04/2001	Franklin, Ronald J., et al.	600	429	07/06/1998
	US-6,333,971	08/06/2002	McCrory, J. , et al.	378	162	12/22/2000
	US-6,351,659	02/26/2002	Vilsmeier, S.	600	407	08/28/1997
	US-6,351,662	02/26/2002	Franck, J. , et al.	600	429	05/24/1999
	US-6,381,485	04/30/2002	Hunter, Mark W., et al.	600	407	10/28/1999
	US-6,430,434	08/06/2002	Mittelstadt, B. D.	600	426	12/09/1999
	US-6,459,927	10/01/2002	Franklin, Ronald J., et al.	600	429	10/27/2000
	US-6,499,488	12/31/2002	Hunter, M. W., et al.	128	899	10/28/1999
	US-RE37,249	06/26/2001	Leibinger, Karl , et al.	606	69	10/12/1993

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Foreign Document No	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	T <sup>2</sup>
	EP-1033113A1 With English Abstract	09/06/2000	Kozac, J.	A61B	10/00	
	EP-1249207A2	10/16/2002	McCrory, J. J., et al.	A61B	6/12	
	WO-01/49197	07/12/2001	Samset, , et al.	A61B	19/00	

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		"Acustar", Z-KAT, Inc., <a href="http://www.z-kat.com/acustar.htm">http://www.z-kat.com/acustar.htm</a> , (2002), 5 pages	
		"Multi-Modality Radiographic Markers", IZI Medical Products, <a href="http://www.izimed.com">http://www.izimed.com</a> , (2002), pp. 1-12	
		"Stryker Navigation System, The Smarter Vision - Image Guided Surgery", Stryker Leibinger Inc., (2002), 8 pages	

EXAMINER

DATE CONSIDERED



Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use as many sheets as necessary)	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 2px;">Complete if Known</td> </tr> <tr> <td style="width: 40%; padding: 2px;"><b>Application Number</b></td> <td style="padding: 2px;">10/688,801</td> </tr> <tr> <td style="padding: 2px;"><b>Filing Date</b></td> <td style="padding: 2px;">October 17, 2003</td> </tr> <tr> <td style="padding: 2px;"><b>First Named Inventor</b></td> <td style="padding: 2px;">Solar, Matthew</td> </tr> <tr> <td style="padding: 2px;"><b>Group Art Unit</b></td> <td style="padding: 2px;">3737</td> </tr> <tr> <td style="padding: 2px;"><b>Examiner Name</b></td> <td style="padding: 2px;">Unknown</td> </tr> <tr> <td colspan="2" style="padding: 5px;"><b>Attorney Docket No: 723.077US1</b></td> </tr> </table>	Complete if Known		<b>Application Number</b>	10/688,801	<b>Filing Date</b>	October 17, 2003	<b>First Named Inventor</b>	Solar, Matthew	<b>Group Art Unit</b>	3737	<b>Examiner Name</b>	Unknown	<b>Attorney Docket No: 723.077US1</b>	
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<b>Examiner Name</b>	Unknown														
<b>Attorney Docket No: 723.077US1</b>															

Sheet 4 of 4

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		CLARYSSE, P , et al., "A Computer-Assisted System for 3-D Frameless Localization in Stereotaxic MRI", <u>IEEE Transactions on Medical Imaging</u> , 10, (1991),523-529	
		COSTE, E , et al., "Frameless Method of Stereotaxic Localization with DSA", <u>Radiology</u> , (1993),829-834	
		LEIBINGER, et al., "Microsurgical Neurectomy Bayonet Scissors", <u>The Leibinger Family of Neurosurgical Products</u> , (1993),1	
		LEIBINGER, "Summary Of Safety And Effectiveness", <u>Marker System for Stereotaxic Navigation</u> , (Mar 1996),pages 38-46	
		LEIBINGER, et al., "The ZD Neurosurgical Localizing Unit...", <u>The FL Fischer Stereotactic Products by Leibinger</u> , (1993),1	
		LEIBINGER, et al., "The ZD Stereotactic System", Leibinger et al. v. McCrory et al., Interference No. 103,657,(1992),19	
		MOTTI, E D., et al., "Head-holder interfacing computed tomography with Talairach stereotactic frame", <u>Journal of Neurosurgical Sciences</u> , 27(3), (1983),219-223	
		ROUSSEAU, J. , et al., "A frameless method for 3D MRI and CT guided stereotaxic localisation", <u>European Radiology</u> , (1992),pp. 1286-1292	
		ROUSSEAU, et al., "Validation of a New Method for Stereotactic Localization Using MR Imaging", <u>Journal of Computer Assisted Tomography</u> , (1991),291-296	
		WALTREGNY, et al., "Application of the Talairach stereotaxic system for the purpose of establishing a common reference plane for braing imaging techniques (CAT scan, NMRI, PET scan)", <u>Revue d Electroencephalographic et de Neuro-physiologie Clinique</u> , 16(3), (1986),269-271	

EXAMINER

DATE CONSIDERED